

REMARKS

Claims 1-9 are all the claims pending in this application.

Claims 1-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lu et al. (hereinafter Lu) (U.S. 5,99,813) in view of Chawla et al. (hereinafter Chawla) (U.S. 6,771,661 B1). Applicant respectfully traverses the 35 U.S.C. § 103 rejection of the claims, as set forth below.

Of the rejected claims, claims 1, 2, and 7 are the only independent claims. The following remarks are for claim 1 and apply by analogy to, although not necessarily coextensive to, independent claims 2 and 7.

Claim 1 recites in part:

said base station comprises means for continuously indicating to said corporate radio terminals the amount of resources they are allocated

The Examiner concedes that Lu does not disclose the feature that said base station comprises means for continuously indicating to said corporate radio terminals the amount of resources they are allocated. However, the Examiner maintains that the above-identified feature is taught in Chawla. (Office Action, page 3)

In particular, the Examiner posits that "Chawla discloses the feature said base station comprises means for continuously (e.g., automatically and dynamically) indicating to said voice, facsimile, computer terminal (210, 211, 212) which reads on the claimed "corporate radio terminals" the amount of bandwidth which reads on the claimed "resources" they are allocated (see col. 10, line 65 - col. 11, line 34; col. 11, lines 55-62; col. 12, lines 6-25; Figs. 3-5), where

the data communications device (201-1, e.g., PBX) provides bandwidth to the terminals (210) of the communication network (200) in which each terminal is provided with allocation information and the base station and means would be inherent for communicating over a wireless transmission link. The system automatically and dynamically adjusts the amount of bandwidth for communication sessions according to situations such as times or events [emphasis added].” (Office Action, pages 3 and 4)

First, Applicant notes that the Examiner’s position seems to intimate that because there is no express indication from the base station to the corporate radio terminals, the base station must have “inherently” indicated to the corporate radio terminals the amount of resources they are allocated in the applied references. Applicant does acknowledge that when a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that a reference “inherently” teaches the missing element or elements of the claimed invention. See In re Oelrich, 666 F.2d 578, 581 (Fed. Cir. 1981).

However, evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. Thus, even if it were assumed, *arguendo*, in this case that the base station 210 in Lu were modified by the teachings of Chawla, such a disclosure is insufficient to meet the burden of *prima facie* obviousness, whereby the base station 210 necessarily comprises means for continuously indicating to said corporate radio terminals the amount of resources they are allocated, because such a feature is not “necessarily present” in the combined teachings of Lu and Chawla.

Second, since both Lu and Chawla make no disclosure regarding (and do not require) a

base station that comprises means for continuously indicating to said corporate radio terminals the amount of resources they are allocated, the same cannot be inherently disclosed in the references. In the combined teachings of Lu and Chawla, it is not a necessary thing that must take place in any of the references for their inventions to operate. Therefore, it is not inherent within the combined teachings of Lu and Chawla that a base station comprise means for continuously indicating to said corporate radio terminals the amount of resources they are allocated, as recited in claim 1.

Third, Chawla neither discloses nor comteplates a base station at all and therefore cannot teach or suggest the feature that said base station comprises means for continuously indicating to said corporate radio terminals the amount of resources they are allocated. In Chawla, resource allocation is done by the data communication device 201 based on an RSVP protocol, network policy, or a template (col. 10, lines 12-21), and the data commuincation device 201 does not read on the above-identified feature. Although Chawla is directed toward a data communication network, Chawla provides no disclosure regarding a base station comprising a means which indicates to terminals 210, 211, and 212 the amount of resources they are allocated, and Chawla has no need to do the same. Furthermore, the Examiner concedes that Lu fails to teach or suggest the above-identified feature, too.

For at least the foregoing reasons, claim 1 and its dependent claim 8 are not anticipated or rendered obvious by the individual or combined teachings of Lu and Chawla. As well, independent claims 2 and 7 and their respective dependent claims 3-6 and 9 are patentable over the individual or combined teachings of Lu and Chawla for analogous reasons. Therefore, the 35

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Application No. 10/084,432

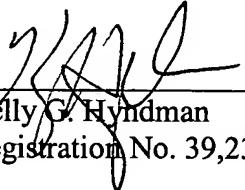
Attorney Docket No. Q68486

U.S.C. § 103 rejection of claims 1-9 should be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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Date: July 21, 2006